

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN C. NELSON and GARY M. VANCE

Appeal No. 1998-2294
Application No. 08/546,298

ON BRIEF

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6, 10-15 and 19-22, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a removable battery compartment cap having a one piece contact assembly (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art of record relied upon by the examiner in rejecting the appealed claims is:

White	1,215,757	Feb. 13,
1917		
Schulte	1,286,800	Dec. 3,
1918		
Edwards et al.	5,108,847	Apr.
28, 1992		
(Edwards)		
Kelly et al.	5,186,665	Feb. 16,
1993		
(Kelly)		

The examiner also relied upon the appellants' admission of prior art set forth on pages 1-4 of the specification and shown in Figures 1A-1C of the drawings (Admitted Prior Art).

Claims 1-6, 10-15 and 19-22 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over the Admitted Prior Art in view of Schulte, White, Edwards and Kelly.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 11, mailed November 26, 1997) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 10, filed September 5, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1-6, 10-15 and 19-22 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellants argue (brief, pp. 4-9) that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require the claimed removable cap to include a contact means or contact assembly having (1) a planar base member for attaching the contact means¹ to the

¹ In claim 22, line 6, "said contact means" should be amended to --said contact assembly-- for proper antecedent basis.

cap member, and (2) a biasing member having a first end that is unitary with the base member and a second end that contacts and is slidable along a surface of the base member when the biasing member is compressed. However, these limitations are not suggested by the applied prior art for the reasons set forth by the appellants in their brief. In that regard, while the prior art to Schulte, White, Edwards and Kelly may suggest the interchangeability between a coiled spring electrical contact and a leaf spring electrical contact, the prior art to Schulte, White, Edwards and Kelly would not have taught or suggested modifying the Admitted Prior Art in a manner to arrive at the claimed invention. Specifically, it is our opinion that the prior art to Schulte, White, Edwards and Kelly would not have taught or suggested modifying the Admitted Prior Art to include a contact means or contact assembly having (1) a planar base member for attaching the contact means to the cap member, and

(2) a biasing member having a first end that is unitary with the base member and a second end that contacts and is slidable along a surface of the base member when the biasing member is compressed.

In our view, the only suggestion for modifying the Admitted Prior Art in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C.

§ 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1-6, 10-15 and 19-22 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject
claims 1-6, 10-15 and 19-22 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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